



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q67366

Nobuyoshi YAGI, *et al.*

Appln. No.: 10/002,300

Group Art Unit: 1773

Confirmation No.: 4399

Examiner: Sheeba AHMED

Filed: December 5, 2001

For: RESIN SHEETS, PROCESSES FOR PRODUCING THE SAME, AND LIQUID
CRYSTAL DISPLAYS

RESPONSE UNDER 37 C.F.R. § 1.111

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

MAR 09 2004

Sir:

Please consider the remarks below in response to the Action mailed December 3, 2003.

Claims 1-25 are all the claims pending in the application.

Applicants respectfully request an acknowledgement in the next communication from the Examiner that the drawings (FIGS. 1-19 on five (5) sheets of drawings) filed with the application on December 5, 2001, have been accepted.

At Section No. 1, page 2, of the Action, the Examiner has acknowledged the election of Group I, Claims 1-7, 9-20, and 22-25. Claims 8 and 21 have been withdrawn from consideration as being drawn to a non-elected invention.

Applicants respectfully remind the Examiner that where claims directed to a product have been elected, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. MPEP §821.04. In the present case, withdrawn Claims 8 and 21 are directed to processes for producing the resin sheets of Claims 1 and 16, respectively. Accordingly, Applicants respectfully request the rejoinder of Claims 8 and 21 upon the allowance of Claims 1 and 16.

Turning to the prior art rejections, as an initial matter, Applicants respectfully point out that Claims 13 and 19 have not been included in a rejection in the present Action. Accordingly, Applicants request an indication that Claims 13 and 19 contain allowable subject matter in the next communication from the Examiner.

At Section No. 2, pages 2-3, of the Action, Claims 1-4, 6-7, 9-12, 14-18, 20 and 22-25 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,495,253 to Koyama, *et al.* ("Koyama").

Applicants respectfully traverse.

Koyama does not disclose the claimed gas barrier layer. For example, Koyama does not disclose the resin sheets of independent Claims 1 and 10, each of which comprises a gas barrier layer and two hard coat layers as outermost layers. Koyama also does not disclose the resin sheets of independent Claims 2, 11, and 16, each of which comprises a gas barrier layer and one hard coat layer as an outermost layer.

In this regard, the transparent polymer films disclosed in Koyama have a different concept from that of the presently claimed gas barrier layer-containing resin sheets. It is a characteristic feature of the claimed resin sheets to contain a gas barrier layer. The presence of a gas barrier layer in the claimed resin sheets makes it possible to shield permeation of moisture into a cell in the case of using the resin sheet as, for example, a liquid crystal cell substrate, thereby preventing improper operation of the cell. Furthermore, it is a characteristic feature of the resin sheets of independent Claims 1 and 10 that the gas barrier layer is not an outermost layer.

Regarding dependent Claims 3 and 4, Koyama does not *expressly* disclose the subject matter thereof.

Koyama, moreover, fails to *inherently* disclose the subject matter of Claims 3 and 4.

The fact that a certain property may be present in the prior art is not sufficient to establish the inherency of that property. In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent property necessarily flows from the teachings of the applied prior art. Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. &

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Inter. 1990). Present Claims 3 and 4 recite a particular surface roughness and peak-to-valley distance, respectively, of an outer surface of the resin sheet. The Examiner has not provided any basis at all for a theory of inherency related to the subject matter of Claims 3 and 4.

For the foregoing reasons, Applicants respectfully request that the Examiner reconsider and withdraw the §102(e) rejection of Claims 1-4, 6-7, 9-12, 14-18, 20 and 22-25.

At Section No. 3, pages 3-4, of the Action, Claims 5 and 12 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Koyama in view of U.S. Patent No. 6,573,958 to Takahashi, *et al.* ("Takahashi").

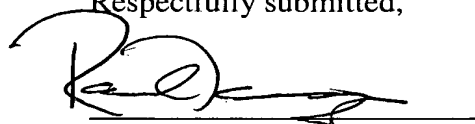
Applicants respectfully request its withdrawal. Applicants have disqualified Takahashi from being proper prior art against the present application by filing herewith a sworn translation of Japan Patent Application No. 2000-370808, from which the present application claims priority.

In particular, Takahashi issued on June 3, 2003, from an application filed November 6, 2001. The '808 Application was filed in Japan on December 6, 2000, and provides full §112 support for the subject matter of Claims 5 and 12 (see paragraph [0031], for example).

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. Raul Tamayo', written over a horizontal line.

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CUSTOMER NUMBER

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